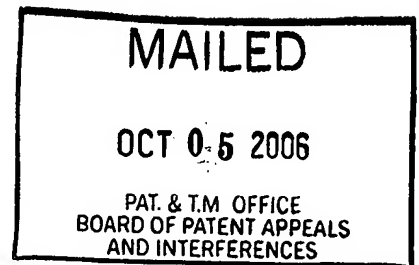


UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCE

Ex parte STEPHEN V. R. HELLRIEGEL and ALEXANDER I. YATSKOV

Application 10/012,210



ORDER RETURNING UNDOCKETED APPEAL TO EXAMINER

This application was electronically received at the Board of Patent Appeals and Interferences (BPAI) on September 11, 2006. A review of the application has revealed that the application is not ready for docketing as an appeal. Accordingly, the application is herewith being returned to the examiner. The matters requiring attention prior to docketing are identified below.

A review of the file indicates that on October 6, 2005, appellants filed an Appeal Brief under the rules set forth in 37 CFR § 41.37(c). However, the Appeal Brief filed on October 6, 2005, does not fully comply with the new rules under 37 CFR § 41.37(c).

37 CFR § 41.37(c) states in part:

(c)(1) The brief shall contain the following items under appropriate headings and in the order indicated in paragraphs (c)(1)(I) through (c)(1)(x) of this section, except that a brief filed by an appellant who is not represented by a registered practitioner need only substantially comply with paragraphs (c)(1)(I) through (c)(1)(iv) and (c)(1)(vii) through (c)(1)(x) of this section:

(x) ***Related proceedings appendix.*** An appendix containing copies of decisions rendered by a court or the Board in any proceeding identified pursuant to paragraph (c)(1)(ii) of this section.

An in-depth review of the Appeal Brief indicates that the following sections are missing from the Appeal Brief filed October 6, 2005:

- 1) “Related Proceedings Appendix,” as set forth in 37 CFR § 41.37(c)(1)(x).

It is required that a supplemental Appeal Brief be submitted that is in compliance with 37 CFR § 41.37(c). For more information on the Board’s new rules, please see the web page entitled “More Information on the Rules of Practice Before the BPAI,” Final Rule at:

<http://www.uspto.gov/web/offices/dcom/bpai/fr2004/moreinfo.html>.

In addition, the Examiner’s Answer mailed December 23, 2005, does not fully in comply with the requirements of 37 CFR § 41.37. The following heading needs to be included in accordance with the Manual of Patent Examining Procedures (MPEP) § 1207.02:

“Related Proceedings Appendix” – Copies of any decisions rendered by a court or the Board in any proceeding identified by the examiner in the “Related Appeals and Interference” section of the answer.

However, the appeal conference is improper. The MPEP § 1208 states:

The participants of the appeal conference should include (1) the examiner charged with preparation of the examiner's answer, (2) a supervisory patent examiner (SPE), and (3) another examiner, known as a conferee, having sufficient experience to be of assistance in the consideration of the merits of the issues on appeal.

...

On the examiner's answer, below the primary examiner's signature, the word "Conferees:" should be included, followed by the typed or printed names of the other two appeal conference participants. These two appeal conference participants must place their initials next to their names. This will make the record clear than an appeal conference has been held. (Emphasis added).

Proper correction of the Examiner's Answer is required.


Accordingly, it is ORDERED that the application is return to the Examiner to:

- 1) hold the Appeal Brief filed on October 6, 2005, defective;
- 2) notify appellants to file a supplemental Appeal Brief in compliance with 37 CFR § 41.37;

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- 3) vacate the Examiner Answer mailed December 23, 2005, in response to the supplemental Appeal Brief, and submit a revised Examiner's Answer in accordance with the new rules effective September 13, 2004; and
- 4) for such further action as may be appropriate.

BOARD OF PATENT APPEALS
AND INTERFERENCES



DALE M. SHAW
Deputy Chief Appeals Administrator
(571)272-9797

DMS/pgc

cc: See Intellectual Property Law Group PLLC
701 Fifth Ave.
Suite 6300
Seattle, WA 98104-7092